

REMARKS

The pending Office Action addresses claims 61-69, 71-89, and 95. Applicant appreciates the Examiner's allowance of claims 72-74, and the Examiner's indication that claims 84-89 represent allowable subject matter. Remaining claims 61-69, 71, 75-83, and 95 stand rejected.

Amendments to the Claims

Applicant amends claim 67 to properly depend from claim 63. Per the Examiner's suggestion, Applicant cancels claim 71. No new matter is added.

Claim Objections

The Examiner objects to claim 67 as lacking antecedent. As indicated above, Applicant amends claim 67 to properly depend from claim 63 thereby obviating the basis for this objection. The Examiner also objects to claims 68 and 71 as having identical scope. As indicated above, Applicant cancels claim 71 thereby obviating the basis for this objection.

Claim Rejections Pursuant to 35 U.S.C. §103

The Examiner rejects claims 61-69, 71, 75-83, and 95 pursuant to 35 U.S.C. §103(a) as being obvious over U.S. Patent 5,725,529 of Nicholson et al. ("Nicholson") in view of U.S. Patent No. 4,870,957 of Goble et al. ("Goble"). The Examiner asserts that Nicholson teaches the claimed invention except for "threading the soft tissue through the aperture." The Examiner relies on Goble to teach this step arguing that it would have been obvious to modify Nicholson in view of Goble to "shorten and simplify the procedure."

Independent claims 61, 75, and 95 each recite a method for anchoring soft tissue within bone including drilling an opening into bone, inserting a stabilizing element into the bone opening, *threading soft tissue through an aperture formed in a proximal portion of an insertion element*, and inserting the insertion element into the stabilizing element. Inserting the insertion element into the stabilizing element is effective to deformably expand the stabilizing element.

One skilled in the art would have no motivation to modify Nicholson in view of Goble to include the step of threading soft tissue through an aperture formed in a proximal portion of an insertion element. The Examiner asserts that:

Goble teaches that it was known to thread soft tissue (37) and a suture (stint (38)) together through an aperture in a similar anchor system; see the abstract and column 6, lines 26-38. Therefore, it is the Examiner's position that it would have been *prima facie* obvious to thread the soft tissue and suture together or the soft tissue only through the aperture of Nicholson (1) for the same reasons that Goble does the same or (2) to avoid an additional soft tissue-to-suture attachment step when one is not needed. This change would shorten and simplify the procedure.

(Office Action dated September 20, 2007, pg. 3). Pursuant to the "Examination Guidelines for Determining Obviousness Under 35 U.S.C 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" (hereinafter "the Guidelines"), when considering obviousness the operative question is "whether the improvement is more than the predictable use of prior art elements according to their established function." The improvement provided by the claimed invention is not predictable in light of Goble and Nicholson. Section E of Nicholson clearly defines a specific emplacement apparatus (99) for installing the expandable member (10) and the insertion element (34). As shown in FIG. 23 and explained at col. 16, lines 30-39 of Nicholson, the emplacement apparatus (99) includes a take-up spool (112) for storage of the free ends of the suture (46). In use, the suture (46) extends proximally through the channel (106) of the insertion element (34), through a hole in the plunger axial channel (106), and over and around the spool (112). When the apparatus (99) is withdrawn from the installation site, the free ends of the suture (46) pay off from the take-up spool (112) to facilitate the attachment of soft tissue. Modifying Nicholson to thread soft tissue through the channel (106) in the insertion element (34) would frustrate the operation of the emplacement apparatus (106) as it would be extremely difficult – if not impossible – to wind the soft tissue around the take-up spool (112). Moreover, the free ends of the soft tissue would most likely clog or jam the emplacement apparatus making the system inoperable. Thus, the modification proposed by the Examiner does not yield predictable results nor does it result in an improved system – in fact, such a modification results in a system *inferior* to the one taught by Nicholson. Accordingly, it would not have been obvious to modify Nicholson in view of Goble and independent claims 61, 75, and 95, as well as claims 62-69, 71, and 76-83 which depend directly or indirectly therefrom, distinguish over Goble and Nicholson and represent allowable subject matter.

Conclusion

In view of the above amendments and remarks, Applicant submits that all claims are in condition for allowance, and allowance thereof is respectfully requested. Applicant encourages the Examiner to telephone the undersigned in the event that such communication might expedite prosecution of this matter.

Respectfully submitted,

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